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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/772,474

02/05/2004

Mitsuru Moriya

YAMAP0388USH

4977

7590

10/20/2004

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EXAMINER

DINH, TAN X

ART UNIT

PAPER NUMBER

2653

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/772,474

Applicant(s)

MORIYA ET AL.

Examiner

TAN X. DINH

Art Unit

2653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 08/577,253.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/05/04
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____

1) This application is a Continuation Application of S/N 10/267,601, filed 10/09/2002 and now is US 6,737,144; which is a Continuation Application of S/N 09/865,308, filed 5/25/2001 and now is US 6,489,002; which is a Continuation Application of S/N 09/698,569, filed 10/26/2000 and now is US 6,280,812; which is a Continuation Application of S/N 09/183,310, filed 10/30/1998 and now is US 6,143,426; which is a Continuation Application of S/N 08/895,787, filed 7/17/1997 and now is US 5,878,018; which is a Continuation Application of S/N 08/577,253, filed 12/22/1995 and now is US 5,726,969. Further, the S/N 09/183,310 has a Continuation Application of S/N 09/295,951, filed 4/21/1999 and now is US 6,031,813.

2) The I.D.S filed 2/05/2004 has been considered by the Examiner. However, the Japan and/or foreign document(s), if they have not been written in English, are considered to the extent that could be understood from the English Abstract and the drawings.

Form PTO-1449 or PTO/SB/08 is(are) attached herein.

3) Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 08/577,253, filed on 12/22/1995.

4) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

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and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970) and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed Terminal Disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5) Claims 1-3,6-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,737,144. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claims 1-3 and 6-8 of this instant application discloses all the subject matter as claimed in claim 1 of U.S. Patent No. 6,737,144 except a light source, a focusing unit and a detecting unit.

However, a light source, a focusing unit and a detecting unit are

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essential and/or inherent elements in every optical disk device for reproducing information data. Therefore, one with ordinary skill in the art the time of the invention was made would have been motivated to use a light source, a focusing unit and a detecting unit for reproducing information data on every dual sides optical disk as claimed.

6) Claims *1-10* are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims *1-6* of copending Application No. 10/772,969 in view of KANNO et al (5,049,428).

Claims *1,2,4,6,7 and 9* in this instant application recite every features of claims *1-6* in copending Application No. 10/772,969, except a reflection film includes aluminum. However, the method of using a reflection film includes aluminum is old and well known in the optical recording art, evident in KANNO et al's figure 1, reflection film 13 and in column 6, lines 52-62. Therefore, one of ordinary skill in the art at the time of the invention was made would have been motivated to use a reflection film includes aluminum in optical recording medium as claimed.

This is a provisional obviousness-type double patenting rejection.

As to claims *3,5,8 and 10*, it would have been obvious to someone

within the level of skill in the art at the time of the invention was made to use a semitransparent reflection film includes gold in any optical disk as claimed, the rationale is as follows:

(i) for all of dual recording layers or multiple recording layers optical disk, the laser beam must goes through intermediate layers before reach to target layer for recording or reproducing information data, the semitransparent reflection layer must be placed between the recording layers for either block the laser beam or let it goes through depends on laser wavelengths, and

(ii) gold and silver are the most efficiency materials for use on reflecting layer and semitransparent reflecting layer because of their superior reflecting characteristics. Therefore, one of ordinary skill in the art at the time of the invention was made would have been motivated to use a semitransparent reflection film includes gold in any optical disk for achieving the best reflecting characteristics.

7) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (See form PTO-892 attached herein).

Applicant is reminded that in amending in response to a rejection of claims (if the rejection involves with any applicable arts), the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the

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objection made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR §1.111(c).

8) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN X. DINH whose telephone number is (703) 308-4859. The examiner can normally be reached on Monday - Friday, 8:00AM - 5:30PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



TAN DINH
PRIMARY EXAMINER

October 15, 2004